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09/441,191 11/15/99 ORAN

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EXAMINER

TM02/0313

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BOSTON MA 02109

CHAMPAGNE, D

ART UNIT

PAPER NUMBER

2162

DATE MAILED:

03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/441,191

Applicant(s)

ORAN, DANIEL P.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-20 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 1999 is/are ~~objected to by the Examiner~~ *see p 7/6/18*.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 15-20 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the first line of each claim, "wherein said processor is further operative with said *processor*" is indefinite.

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 7, 8, 14 and 19 are rejected under 35 USC 102(e) as being anticipated by Bezos et al. (US Pat. 6,029,141).

Bezos et al. teaches a method and apparatus for facilitating and tracking personal referrals, comprising (col. 2 lines 19-47): generating a unique identifier, a *unique associate ID* (col. 2 line 42), for the pairing of an individual (col. 1 line 21) and one offer to become an associate; sending to said individual an electronic-mail message that contains a web page (col. 2 lines 23-24) whose address or contents include said unique identifier or a transformation thereof; and providing in said web page instructions for building a website with referral links (col. 2

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line 46), which reads on "providing in said web page a means of inputting the electronic-mail address of persons whom said individual wishes to refer".

6. Claims 9-11 are rejected under 35 USC 102(e) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Bezos et al.

Bezos et al. does not teach providing a means in the web page of opting out of receiving electronic mail messages. However, since Bezos et al. teach the method claimed, under the principles of inherency (MPEP § 2112.02) the invention is considered to be anticipated in this regard by Bezos et al. As evidence tending to show inherency, it is noted that any web page can be closed by a viewer, which would constitute opting out of the application process.

7. Claims 3, 12, 13, 15 and 20 are rejected under 35 USC 103(a) as being obvious over Bezos et al.

Bezos et al. does not teach (claims 3 and 15) determining if the individual has previously been sent an electronic-mail message about the offer. However, because Bezos et al. does teach that scrutiny of associate applications is important (col. 9 lines 46-47), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine if the individual has previously been sent an electronic-mail message about the offer, which would only occur if the previous offer had been withdrawn due to failure to meet standards set for associates.

Bezos et al. does not teach (claims 12, 13 and 20) determining if the offer is still valid and sending electronic-mail messages to persons referred by the individual. Since there would be no point in distributing invalid offers, it would be obvious to determine if a prospective offer were still valid. Since the point of getting referrals is to communicate with the referred persons, particularly to verify their orders, this also would have been obvious to one of ordinary skill in the art, at the time of the invention.

Allowable Subject Matter

8. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. ¹⁶Claims ~~16-18~~ would be allowable if rewritten to overcome the rejection(s) under 35 USC 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art, Bezos et al., teaches a self-selecting method for recruiting individuals, i.e., a web site which is voluntarily selected by candidate individuals. There would be no point with such a system, and indeed it would not even be possible to, determine whether an individual had previously opted out of receiving electronic-mail messages (previously terminated the associate application process without submitting an application). Hence the inventive feature of the instant invention could not be anticipated by the closest prior art, and is not obvious from the prior art.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is (703)308-3331. The examiner's normal work schedule is 6:30 AM to 5 PM ET Monday through Thursday.

Donald L. Champagne
12 March 2001

